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10/087,561	03/01/2002	Steven W. Lundberg	1551.002US1	2170

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/087,561	LUNDBERG ET AL.
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 August 2006 and 20 March 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12-28 and 30-35* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,12-28 and 30-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date <u>20070320, 20060814</u>.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

Request for Continued Examination

1. The Request filed on 3/20/2007 for Continued Examination (RCE) under 37 CFR 1.114

based on parent Application No. 10/087,561 is acceptable and a RCE has been established.

An action on the RCE follows.

Response to Amendment

2. Claims 11, 29, and 36 have been cancelled; therefore, Claims 1-10, 12-28, and 30-35 are

currently pending in application 10/087,561.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
>> (e) the invention was described in (1) an application for patent, published under section 122(b), by another
>> filed in the United States before the invention by the applicant for patent or (2) a patent granted on an
>> application for patent by another filed in the United States before the invention by the applicant for patent,
>> except that an international application filed under the treaty defined in section 351(a) shall have the effects
>> for purposes of this subsection of an application filed in the United States only if the international
>> application designated the United States and was published under Article 21(2) of such treaty in the English
>> language.

4. **Claims 1-10, 12-28 and 31-35 are rejected under 35 U.S.C. 102(e) as being anticipated**

by Grainger et al. (US 2002/0065677 A1).

5. As per **independent Claim 1**, Grainger discloses a system for managing information

disclosure statement (IDS) references, comprising: a computing system (Fig. 1); a first

software component operable on the computing system to generate a plurality of IDS forms (Fig.5, Para 0038-0039, completer and transmit IDS using IDS generation program); and a second software component operable on the computing system to manage IDS references for at least one organization (Fig.3 and 5, IDS storage); wherein each organization only has access to its own IDS references (Para 0038, Documents stored in user database; Para 0079-0081, restricted access).

6. As per Claim 2, Grainger discloses a third software component operable on the computing system to provide a presentation for managing the IDS references associated with each matter of the at least one organization (Figs.13A-20).

7. As per Claim 3, Grainger discloses a fourth software component operable on the computing system to manage matters for the at least one organization; wherein the second software component is a part of the fourth software component (Fig.13A, Prior Art associated with Case).

8. As per Claim 4, Grainger discloses a fifth software component operable on the computing system to manage activities within matters; a sixth software component operable on the computing system to manage organizations; a seventh software component operable on the computing system to manage tasks within matters; an eighth software component operable on the computing system to provide communications; and a ninth software component operable on the computing system to provide security; wherein the third, fourth, fifth, sixth, seventh, eighth, and ninth software components are capable of interfacing with the first and second software components in a patent prosecution enterprise application (Figs.13A-20).

9. As per Claim 5, as understood by the Examiner, Grainger discloses wherein the IDS

references comprise: an IDS holder; an IDS patents holder related to the IDS holder; an IDS

publications holder related to an IDS table; and an IDS source holder to indicate how to

access the stream of data associated with each IDS reference (Figs.13A-20).

10. As per Claim 6, Grainger discloses a matter holder related to the IDS holder; and an

organization holder related to both the IDS holder and the IDS source holder (Figs.13A-20).

11. As per Claim 7, Grainger discloses a database management system to manage the holders

(Figs.13A-20).

12. As per Claim 8, Grainger discloses wherein the holders are tables and the data management

system is a relational database management system (Figs.13A-20).

13. As per Claim 9, Grainger discloses wherein the holders are classes and the data management

system is an object-oriented database management system (Figs.13A-20).

14. As per **independent Claim 10**, Grainger discloses a method for IDS reporting, comprising:

receiving a report specification (Electronic File); interpreting the report specification;

generating an answer file (converting information format); receiving a plurality of

transformations to act on the answer file and an IDS form definition file; and providing an

IDS report (Para 0038-0039, Display in IDS form).

15. As per Claim 12, Grainger discloses receiving a question file; wherein interpreting the report

specification includes reading the question file (Para 0038).

16. As per **independent Claim 13**, Grainger discloses a method for managing information

disclosure statement (IDS) references, comprising: receiving a request to add an new

information disclosure statement (IDS) reference to a first matter (Fig.5); searching for all

matters related to the first matter (Fig.5, Search for information); and adding the new IDS

reference to selected matters related to the first matter (Fig.5, Create form).

17. As per Claim 14, Grainger discloses selecting only those matters related to the first matter

with a matter type that supports IDS reference management and only those matters having an

appropriate stage (Figs.13A-20).

18. As per Claim 15, Grainger discloses presenting a list of IDS references for a second matter,

wherein the second matter is related to the first matter; and indicating the new IDS reference

in the list originated in the first matter (Para 0008).

19. As per Claim 16, Grainger discloses indicating the new IDS reference is unmarked and

unreviewed (Fig.20)

20. As per **independent Claim 17**, Grainger discloses a system for managing information

disclosure statement (IDS) references, comprising: a computing system; a presentation layer

operable on the computing system to present an information disclosure statement (IDS)

reference inventory system; a business logic layer operable on the computing system to

manage the IDS reference inventory system and to generate IDS forms (IDS processing

system); and a data layer operable on the computing system to manage the data associated

with the IDS reference inventory system (Fig.11).

21. As per Claim 18, Grainger discloses wherein the computing system comprises: a web server;

at least one browser in communication with the web server; and a file system accessible to

the web server; wherein the presentation layer, the business logic layer, and the data layer

operate on the web server (Fig.11).

22. As per Claim 19, Grainger discloses wherein the computing system comprises: a web server; at least one browser in communication with the web server; and a database management system accessible to the web server; wherein the presentation layer and the business logic layer operate on the web server and the data layer operates on the database management system (Fig.11).

23. As per Claim 20, Grainger discloses wherein the computing system comprises: a web server; at least one browser in communication with the web server; an application server in communication with the web server; and a database management system in communication with the application server; wherein the presentation layer operates on the web server, the business logic layer operates on the application server, and the data layer operates on the database management system (Fig.11).

24. As per **independent Claim 21**, Grainger discloses a computer-readable medium storing computer-executable instructions for performing a method, the method comprising: providing a presentation capable of associating at least one information disclosure statements (IDS) reference to at least one matter; and providing a presentation capable of listing each IDS reference associated with each matter (Figs.13A-20), and restricting access to IDS references so that each organization only has access to it own IDS references (Para 0079-0081, restricted access).

25. As per Claim 22, Grainger discloses providing a presentation capable of generating an IDS form for at least one matter (Para 0038-0039).

26. As per Claim 23, Grainger discloses providing a presentation capable of modifying at least one IDS reference associated with at least one matter (Figs.13A-20).

27. As per Claim 24, Grainger discloses providing a presentation capable of deleting at least one

    IDS reference associated with at least one matter (Figs.13A-20).

28. As per Claim 25, Grainger discloses providing a presentation capable of searching all IDS

    references associated with one matter (Figs.13A-20).

29. As per Claim 26, Grainger discloses providing a presentation capable of searching all IDS

    references owned by one organization (Figs.13A-20).

30. As per Claim 27, Grainger discloses providing a presentation capable of marking at least one

    IDS reference associated with at least one matter (Figs.13A-20).

31. As per Claim 28, Grainger discloses providing a presentation capable of updating a review

    status of at least one IDS reference associated with at least one matter; and providing a

    presentation capable of showing the review status of each IDS reference associated with at

    least one matter (Fig.20)

32. As per Claim 31, Grainger discloses wherein presentation capabilities for each individual are

    determined based on their role in a matter and an organization associated with each

    individual (Para 0079-0081, Restricted Access).

33. As per Claim 32, Grainger discloses providing a presentation capable of uploading a stream

    of data associated with the at least one IDS reference (Para 0054, Activate Link/Pointer to

    IDS file).

34. As per Claim 33, Grainger discloses providing a presentation capable of downloading the

    stream of data associated with the IDS reference (Para 0054, Attach Link/Pointer to IDS file).

35. As per Claim 34, Grainger discloses providing links for various applications capable of

    opening and displaying the stream of data (Para 0054, Attach Link/Pointer to IDS file).

36. As per Claim 35, Grainger discloses providing a presentation capable of uploading a plurality

of streams of data associated with IDS references, the IDS references being associated with a

plurality of matters (Para 0054, Attach Link/Pointer to IDS file).

Claim Rejections - 35 USC § 103

37. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
> in section 102 of this title, if the differences between the subject matter sought to be patented and the
> prior art are such that the subject matter as a whole would have been obvious at the time the invention
> was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability
> shall not be negatived by the manner in which the invention was made.

38. **<u>Claim 30</u> is rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger in**

view of Official Notice.

39. As per Claim 30, Grainger fails to expressly disclose providing an accounting system to track

costs associated with storing IDS references.

40. However, one advantage to Grainger's system is the ability to manage costs involved with

handling IDS information (Para 0089). Furthermore, Official Notice is taken that the

accounting function was a well-known part of doing business when the invention was made,

for the purpose of tracking expenses and revenues of a company for owner/stockholder and

government/tax reasons (An Example of such Accounting Management can be found in

"Cost Management: Accounting & Control" by Don R. Hansen and Maryanne M. Mowen,

South-Western College/West; 4 edition, February 21, 2002). Finally, the database costs

would be an obvious accounting element to track in such a database intensive system.

Response to Arguments

41. Applicant's arguments filed 8/14/2006 and 3/20/2007, with respect to Claims 1-10, 12-28, and 30-35 have been considered but are not persuasive. The rejection will remain as NON-FINAL, based on the sited prior art. Please see the Examiner's response to Applicant's arguments below and in the revised rejection above.

42. As per Independent Claims 1 and 21, the Applicant has made the argument that the sited prior art fails to teach or disclose a second software component operable on the computing system to manage IDS references for at least one organization; wherein each organization only has access to its own IDS references.

43. However, Grainger teaches a system with an electronic IDS/electronic document storage component (Para 0038). Grainger also discloses controlling user access rights to the IDS information (Para 0081, organizations maintain control of who access their IDS records through access codes).

44. The Applicant has also made the argument that the sited prior art fails to teach or disclose a second software component operable on the computing system to manage IDS references for at least one organization.

45. However, Grainger does disclose a storage system for the created electronic IDS (Fig.3 and 5).

46. As per Independent Claim 10, the Applicant has made the argument that the sited prior art fails to teach or disclose generating an answer file, and receiving a plurality of transformations to act on the answer file and an IDS form definition file.

47. However, Grainger does disclose receiving electronic document information (report

specification) and automatically extracting relevant portions of the reference information

(equivalent to generating an answer file and receiving a plurality of transformations to act on

the answer file and an IDS form definition file) from the electronic document into an

electronic information disclosure document statement (Para 0038-0039, create IDS report).

48. As per Independent Claim 13, the Applicant has made the argument that the sited prior art

fails to teach or disclose searching all matters related to the first matter, and adding the new

IDS reference to selected matters related to the first matter.

49. However, Grainger does disclose a system for creation of an IDS, which determines that a

new IDS will be generated or IDS edited (first matter determined, searches for documents

(searches all matters related to the first matter), then downloading and extracting information

to create the IDS (adding new matters/electronic information to selected matters/previously

extracted information related to the first matter) (Fig.5 flow chart).

50. As per Independent Claim 17, the Applicant has made the argument that the sited prior art

fails to teach or disclose a business logic layer.

51. However, Grainger discloses a system (equivalent to business logic later) for creating,

storing, and managing electronic IDS information, and storing and managing electronic

document information (Fig.2, Figs. 13c-14, Para 0038-0039).

52. The remaining arguments regarding the dependent claims are addressed in the rejection of

the claims above.

Conclusion

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

54. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.

55. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

April 30, 2007

JONATHAN OUELLETTE
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TECHNOLOGY CENTER 3600